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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : FUHRMANN ET AL.
Serial No. : 09/125,700
Filed : 23 October 1998
For : RADIOTELEPHONE
Group No. : 2684
Examiner : CHIANG, JACK

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Commissioner for Patents
Washington, D.C. 20231

Sir:

APPELLANTS' BRIEF ON APPEAL

This Brief is submitted in triplicate on behalf of Appellant for the application identified above. Please charge the \$330.00 fee for filing a Brief on Appeal and any additional necessary fees to Deposit Account No. 50-2032.

REAL PARTY IN INTEREST

The real party in interest for this appeal is the assignee of the application, Nokia Mobile Phones Limited.

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RELATED APPEALS AND INTERFERENCES

There are no currently-pending appeals or interferences relating to the present application.

STATUS OF THE CLAIMS

Claims 1-9, 11-13, and 15-17 are pending in the application. All pending claims stand finally rejected. All pending claims are rejected under 35 U.S.C. § 112, first paragraph, and either failing to comply with the enablement requirement, or as containing subject matter not described in the Specification, or both. Claims 1-9, 11-12, and 15-17 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,722,055 to *Kobayashi et al.* Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kobayashi et al.* in view of U.S. Patent No. 5,235,566 to *Takagi, et al.* All of the rejected claims, claims 1-9, 11-13, and 15-17, are appealed.

STATUS OF AMENDMENTS

No amendments to the claims were filed following the final Office Action, which was mailed 27 August 2003.

SUMMARY OF THE INVENTION

The present invention is directed to an electronic radiotelephone, for example a cordless telephone or mobile phone. Specifically, the invention is directed to the configuration of a multipart housing for containing the radiotelephone's internal components. As with conventional housings, the basic purpose of the housing is to protect the internals, to provide a functional but attractive outer appearance, and to provide an ergonomic shape so that the instrument may be conveniently held while in use.

Radiotelephones have conventionally used a housing that is not easily alterable by the user because its separate pieces are either glued together with an adhesive or fastened with screws or similar fasteners. Indeed, the housings of these conventional phones were not intended to be separated by the user under normal circumstances.

As radiotelephones became more popular and affordable, and available to a wider segment of the population, the demand for more attractive, even stylish designs grew. Manufacturers responded by making radiotelephones that sported a more interesting shape, color, or both, than their predecessors. Still, these features were largely unchangeable. Once a phone was selected, the user's ability to control its appearance was restricted.

The radiotelephone configuration of the present invention provides the user with the option to easily change the appearance of the phone they are using without having to purchase a new one. A user-releasable housing allows users to modify their radiotelephone to suit their own individual tastes.

To accomplish this objective, the radiotelephone of the present invention includes a first housing (2)¹ and a second housing (14), the second housing (14) being releasably attached to the first housing (2), generally at the phone's periphery. (*See, e.g.*, page 1, lines 21-23)² The first and second housings provide front and rear outer casings for the phone (page 2, lines 11-12). To achieve "user-releasability" of the second housing (14), a press-on/catch closure (11) is

¹ Unless otherwise noted, the reference numbers cited in this Brief are found in the embodiment of Figures 1 through 3 of the pending Application. The claims have been amended throughout prosecution, however, and no one figure by itself illustrates all features of the pending claims.

² Page and line numbers refer to the Specification as originally filed. The pages of the original Specification were numbered; the line numbers used in this Brief start counting from the first line of a page's text, including subsequent blank lines.

employed as an attachment means. The structure of this attachment means is shown in Figures 1 through 3 and its operation is described in the Specification at, for example, page 5, lines 22-28. As should be apparent, in the claims there are recited several “ housings ” that together form an assembly for “ housing ” the phone’s internals. It is believed, however, that the individual housings (for example the “ first housing ”) that form this assembly are described in the claims sufficiently to avoid any confusion that might otherwise result from the use of this nomenclature.

A retaining means including a cover (3) is provided so that it retains the radiotelephone’s internals components (to the first housing) when the second housing is released from attachment with the first housing (page 1, lines 23-25). Only a small number of internal components are shown in great detail in Figures 1 through 3, such as the display (9), but others are illustrated in Figure 5. Note the exact number and specific type of components disposed internally are not important to the present invention.

One internal component that is explicitly referred to in the claims of the present invention is a key sensor. A conventional phone has a number of such sensors, which act as switches that the user can activate to interface with the phone. These sensors would be, for example, key domes 29a of membrane 29 shown in Figure 5 and described on page 8, lines 7-13. In one conventional configuration, when forced inward the membrane key dome electrically connects two separate conductors disposed on the surface of circuit board 23. Other configurations are possible, of course, but the exact manner of operation of the sensors is not within the scope of the claims of the present invention.

As should be apparent, the key sensors are not directly accessible to the user. Instead, a key unit, which may also be called a button or key, when pushed by the user transfers the applied activation force (in the telephone of Figure 5, via key dome 29a) to the sensor. As also shown in Figure 5, key units may form part of a key mat, which holds the keys in their proper fixed apart configuration and may be useful in helping to hold them in place in the assembled phone as well.

The claims of the present invention each include at least one key unit (8), which the user may use to activate at least one key sensor. (page 1, line 30 to page 2, line 1; page 2, lines 23-24) (In most but not all cases, there will be a number of key units, each for activating a sensor.) The key unit (8) may be retained in place by the cover (3), or by the second housing (14) when it is attached (page 1, line 30 to page 2, line 1; page 2, lines 17-24).

ISSUES ON APPEAL

Claims 1-9, 11-13, and 15-17 are rejected under 35 U.S.C. § 112, first paragraph, for either failing to comply with the enablement requirement, or as containing subject matter not described in the Specification, or both. Claims 1-9, 11-12, and 15-17 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,722,055 to *Kobayashi et al.* Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kobayashi et al.* in view of U.S. Patent No. 5,235,566 to *Takagi, et al.*

The issues on appeal are:

1. Whether claims 1-9, 11-13, and 15-17 were properly rejected under § 112, first paragraph as failing to comply with the enablement requirement;
2. Whether claim 6 was properly rejected under § 112, first paragraph failing to comply with the enablement requirement; or as containing material that was not adequately described in the original Specification, or both; and
3. Whether claims 1-9, 11-12, and 15-17 were properly rejected under § 102(e) as being anticipated by *Kobayashi et al.*

Note that the separate rejection of claim 13 under § 103(a) (which depends on issue 3 being decided unfavorably to Appellant) is not being addressed in this Appeal.

Finally, in paragraphs 7-9 of the Office Action dated 27 August 2004, the Examiner conditionally drafted a rejection for use if “Fig. 6 is entered”. According to paragraph 1 of the Office Action, Fig. 6 has not been entered. This rejection is therefore not an issue on Appeal.

GROUPING OF CLAIMS

Claims 1-9, 11-13, and 15-17 are rejected under 35 U.S.C. § 112, first paragraph, for either failing to comply with the enablement requirement, or as containing subject matter not described in the Specification, or both. Claims 1-9, 11-12, and 15-17 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,722,055 to *Kobayashi et al.* Claim 13 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kobayashi et al.* in view of U.S. Patent No. 5,235,566 to *Takagi, et al.*

For purposes of this appeal, the pending claims will be grouped together as follows:

Group A - claims 1-5, 7-9, 11-13, and 15-17 (all pending, rejected claims);

Group B – claim 6.

Groups A and B stand or fall independently. Patentability of the claims within each group is argued separately below.

ARGUMENT

Group A

In paragraph 3 of the Office Action mailed 27 August 2003, claims 1-9, 11-13, and 15-17 were rejected under § 112, first paragraph, for containing subject matter that was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the Examiner noted that all pending claims include a “press-on catch”, stating that this feature was not included in the original Specification “for the phone structure itself”. With regard to this ground of rejection, the claims of Group A stand or fall together. (Claim 6 is not included because it is also subject to rejection for other reasons, which if sustained do not affect the patentability of the claims in Group A)

The feature questioned by the Examiner is recited explicitly in each of the independent claims 1, 15, 16, and 17 as a “press-on/catch closure”. The press-on/catch closure functions as an attachment means for attaching one housing to another. In claims 1, 16, and 17, this refers to the “first housing” and the “second housing”. In claim 15, it refers to the back housing” and the “front housing”. This use is explicitly recited in the Specification and shown in the Drawings:

[Referring to Figure 1] On each side of the side walls 6, extending in the longitudinal direction of the housing 1 there are two attachment means 11, at a distance from one another, which are designed as *press fit/catch closures*. . . . The attachment means have a catch projection 12 which is biased outward in a sprung fashion and can be pressed inwards into the housing 1 against the outwardly acting spring force by means of an externally-accessible activation element 13. The attachment means serve to attach to the housing element 1 an external wall element 1 which is fitted over the shell-shaped housing element 3 and is also of shell-shaped design.

| page 5

(Page 5, lines 22-30(*emphasis added*)). As should be apparent, the variation of nomenclature used in the Specification and the claims is not relevant to this issue.

In making this rejection, the Examiner did note that the press-on catch was not found in the original claims or in Figure 5. Appellant respectfully suggests this is not material; disclosed features may be added to the claims regardless of whether they are shown in every Drawing. The Examiner, in paragraph 3 of the Office Action, also stated that the original Specification did not disclose “a press-on catch for the phone structure itself”. The meaning of this comment is not entirely clear to Appellant, but it seems to imply that the attachment means of the Specification is somehow not used in the same fashion as the attachment means of the claims. Note, however, that the recited purpose of the claimed press-on catch closure is (for example, in claim 1) to releasably attach the second housing to the first housing so that the second housing may be fitted on to the first housing by pressing it on. In the Specification, this limitation is disclosed on page 7, lines 15-16 (“wall element 14 is fitted on to the housing 1 by simply pressing it on”).

Note while the structure and operation of attachment means 11 is described in some detail at page 6, line to page 7, line 13, the claims do not require that this exact configuration. It could be used, however, in accordance with the claimed invention, meaning that the Applicants were in possession of the claimed invention at the time of application.

In paragraph 5 of the Office Action mailed 27 August 2004, claims 1-9, 11-12, and 15-17 of Group A were rejected under 35 U.S. C. § 102(e) as being anticipated by Kobayashi et al. (U.S. Patent No. 5,722,055). Claim 6 of Group A was rejected under 35 U.S. C. § 103(a) as being unpatentable over Kobayashi et al. in view of Takagi et al. (U.S. 5,235,566). The claims of Group A are properly grouped together with regard to these two grounds of rejection because the

first applies to all of the claims except claim 13, and Appellant, while not agreeing or disagreeing with the Examiner's conclusions concerning the separately patentability of claim 13, elects to have it stand or fall with the rest of the claims in Group A.

With all due respect, the Examiner's rejection of claims 1-9, 11-12, and 15-17 on this ground is unsustainable. Each of the independent claims (and therefore all of the claims in Group A) include a press-on/catch closure used to releasably attach one housing portion of the radiotelephone to another. The Examiner's analysis of the independent claims in paragraph 5 simply does not address this feature. In fact, in paragraph 9 of the Office Action, the Examiner states that this feature is *not present* in *Kobayashi et al.*

Regardless of whether this element was present in the claims as originally filed, it is properly part of the currently pending claims. (This particular feature was added in an Amendment dated 20 January 2002.) The Examiner has acknowledged that the claims have been thus amended in formulating the § ^{112?} ~~122~~ rejections addressed above, but has nevertheless addressed the § 102 rejection to a previous version of the claims. Appellant acknowledges that there have been submitted changes to the Specification and to the Drawings that the Examiner has refused to enter. This refusal, while still desirable, is not at issue in this Appeal, and Appellants in this Brief nowhere rely on or cite to the un-entered materials.

Finally, in paragraphs 7-9 of the Office Action dated 27 August 2004, the Examiner drafted a rejection for use if "Fig. 6 is entered", namely that claims 1-9, 11-12, and 15-17 would be rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kobayashi et al.* in view of *Semenik et al.* (U.S. Patent No. 5,233,506). According to paragraph 1 of the Office Action, Fig. 6 has not been entered. This rejection is therefore not an issue on Appeal. If the Examiner

changes position with respect to this ground for rejection, or if requested to do so by the Board, Appellant will present detailed arguments traversing this rejection.

In general, however, neither reference discloses a second (or front) housing that is releaseably attached to a first (or back) housing by a press-on/catch closure that may be conveniently used to modify the appearance of the radiotelephone in combination with a retaining means for holding internal components of the phone when the second (or front) housing is released from attachment. *Kobayashi et al.*, in fact, teaches the use of tapping screws that pass from the rear of the unit through numerous components to the front. (See, for example, col. 17, lines 30-67.) This configuration decidedly teaches away from a user-releasable housing; these screws are clearly meant for ease of construction, not removal by the consumer. When removed, the various components the screws are meant to secure will be freed along with the front case member. Removal by the user, for example to substitute another cover to change the appearance of the phone, would certainly not be recommended.

The disclosure of *Semenik et al.* does not remedy this failure to disclose these advantageous features of the present invention. While it does disclose the use of a press-fit fastener for releasably fastening two housing portions together, it also discloses no retaining means for holding the components of the phone when the housings are released from their fastened configuration. The disclosure presents little or no detail in this respect, it is simply directed to the fastener itself. In addition, referring to Figures 3-5 and 9, it is clear that when fastened, the fastener disappears from view. While Figure 8 does show a tool apparently poised to effect release of the fastener, a cutaway view is necessary. This phone, like the one shown in *Kobayashi et al.*, is not designed for appearance modification by the user.

Group B

In paragraph 2 of the Office Action mailed 27 August 2003, claim 6 was rejected under 35 U.S. C. § 112, first paragraph, for failing to comply with the enablement requirement. The Examiner stated that claim 6 contained subject matter that was not described in the Specification in such a way as to enable one skilled in the art to make or use the invention.

In paragraph 2 of the Office Action mailed 27 August 2003, claim 6 was also rejected under § 112, first paragraph, for containing subject matter that was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 6 depends from claim 3, which depends from claim 1. Claim 1 recited a retaining means comprising a cover for holding internal components of the phone; claim 3 recites that the retaining means also comprises a circuit board. In claim 6, then, the retaining means includes a cover and a circuit board, and they are releasably engagable with each other so that the user may exchange covers easily without the use of a special tool.

This configuration is explained in the Specification at page 1, line 27 through page 2, line 9, which concludes “the cover is most preferably releasably attachable [to the first housing, either directly or via other components of the retaining means] – for example by spring clips.” The term “spring clips” is not further defined on pages 1-2 in the Specification, but does imply the use of a clip member biased into place by a spring or other resilient element. This meaning is confirmed on page 9, which refers to Figure 5. Described there is a frame 35 being releasably engaged with a circuit board 23 using spring clips 38 (page 9, lines 20-27).

The Examiner notes that the Specification does mention screws. While nothing in the nature of a screw requires the use of a screwdriver, the Examiner evidently believes that one would be used for operating the screws mentioned in the Specification and that a screwdriver is a “special tool”. It is not necessary to reach this question, since the spring clips described in the relevant portions of the Specification (cited above) are definitely not screws.

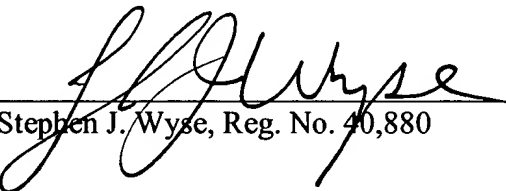
The Examiner also notes that the Specification refers to a “pointed object”. This citation, however, is to page 7 (line 9), where attachment means 11 is being discussed. It is not attachment means 11 (for example, the press-on/catch closure) that is being referred to in claim 6 as not requiring the use of a special tool to operate. Claim 6 instead is referring to the releasably engagable relationship between the cover and the circuit board.

CONCLUSION

None of the cited references, taken alone or in combination, show or suggest all of the features of the invention claimed in Groups A & B. Therefore, the rejections under 35 U.S.C. §102 and §112 are improper. (By election of the Appellant and of the Examiner, no § 103 rejections are at issue on this Appeal.) The Applicants respectfully request that the Board of Appeals reverse the decision of the Examiner in which all of the pending claims of the application were rejected.

Respectfully submitted,

Dated: 26 MARCH 2004



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APPENDIX – CLAIMS ON APPEAL

1. (Previously amended) An electronic radiotelephone comprising:
a first housing;
a second housing user releasably attachable to the first housing to meet with the first housing around the periphery of the radio telephone, wherein the second housing modifies the external appearance of the electronic radiotelephone to the personal tastes of the user;
at least one key unit for user-actuation of at least one key sensor;
retaining means comprising a cover, for holding electronic components of the radiotelephone, including said key sensor but excluding said key unit, to the first housing when the second housing is released from attachment with the first housing by the user, wherein said key unit being free to move with respect to the first housing when the second housing is released from attachment with the first housing by the user; and
wherein said second housing is releasably attachable, by the user, to the first housing by a press-on/catch closure so that said second housing may be fitted on-to the first housing by pressing it on.
2. (Original) An electronic radiotelephone as claimed in claim 1, wherein the second housing is a user interface housing of the radiotelephone.
3. (Previously amended) An electronic radiotelephone as claimed in claim 1, wherein the retaining means comprises a circuit board of the radiotelephone.
4. (Previously amended) An electronic radiotelephone as claimed in claim 3, wherein said at least one key sensor is provided on an outer surface of the circuit board.
5. (Previously amended) An electronic radiotelephone as claimed in claim 3, wherein the cover is arranged to hold components of the radiotelephone between it and the said

circuit board.

6. (Previously amended) An electronic radiotelephone as claimed in claim 3, wherein the cover is releasably engageable with the circuit so that a user may exchange covers easily without the use of a special tool.

7. (Previously amended) An electronic radiotelephone as claimed in claim 1, wherein at least one user interface component is retained by the cover.

8. (Original) An electronic radiotelephone as claimed in claim 7, wherein the cover includes an aperture overlying at least one user interface component retained by the cover.

9. (Previously amended) An electronic radiotelephone as claimed in claim 1, wherein a sealing member is retained by the cover.

10. (Cancelled).

11. (Previously amended) An electronic radiotelephone as claimed in claim 1, wherein when the second housing is attached to the first housing, the key unit is sandwiched between the second housing and the key sensor.

12. (Previously amended) An electronic radiotelephone as in claim 1, wherein the key unit is a key mat.

13. (Previously amended) An electronic radiotelephone as claimed in claim 12, wherein the key sensor comprises a membrane switch.

14. (Cancelled).

15. (Previously amended) An electronic radiotelephone comprising:
a back housing providing at least one key sensor;
at least one key unit for user-actuation of at the least one key sensor by a user;
a front housing for modifying the external appearance of the electronic
radiotelephone to the personal tastes of the user, the front housing having at least one opening for
receiving said at least one key unit for user-activation, and being user-releasable attachable to the
back housing to meet with the back housing around the periphery of the radiotelephone, and
retaining means comprising a cover, holding electronic components of the radiotelephone to the
back housing when the front housing is released from attachment with the back housing by the
user;

wherein when the front housing is attached to the back housing, the key unit is
held between the front housing and the at least one key sensor and the key unit is thereby
received in the at least one opening of the front housing;

said key unit being user removable when the front housing is released from
attachment with the back housing by the user, and;

wherein said front housing is releasably attachable by the user to the back housing
by a press-on/catch closure so that said front housing may be fitted on to the back housing by
pressing it on.

16. (Previously amended) An electronic radiotelephone comprising:
- a first housing;
 - a second housing for modifying the external appearance of the electronic radiotelephone to the personal tastes of an user, the second housing is releasable attachable, by the user, to the first housing to meet with the first housing around the periphery of the radiotelephone;
 - at least one key unit for user-actuation of at least one key sensor;
 - retaining means comprising a cover, for holding electronic components of the radiotelephone to the first housing when the second housing is attached to the first housing with the first housing, wherein when the second housing is attached to the first housing, the key unit is sandwiched between the second housing and the at least one key sensor, said key unit being free to move with respect to the first housing when the second housing is released from attachment with the first housing by the user; and
 - wherein said second housing is releasably attachable, by the user, to the first housing by a press-on/catch closure so that said second housing may be fitted on-to the first housing by pressing it on.

17. (Previously amended) An electronic radiotelephone comprising:
a first housing;
a second housing for modifying the external appearance of the electronic radiotelephone to the personal tastes of an user, the second housing releasable attachable, by the user, to the first housing to meet with the first housing around the periphery of the radiotelephone;

attachment means for attaching the second housing to the first housing by a user without employing a tool, wherein said second housing is reasably attachable to the first housing by said attachment means which comprises a press-on/catch closure so that said second housing may be fitted on-to the first housing by pressing it on;

at least one key unit for user-actuation of at least one key sensora and retaining means comprising a cover, for holding electronic components of the radiotelephone, including said key sensor but excluding said key unit to the first housing when the second housing is released from attachment with the first housing, said key unit being free to move with respect to the first and second housings when the second housing is released from attachment with the first housing by the user.

18-24. Canceled.